

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Express Mail Label: EV 107635791 US
Mailing Date: June 15, 2002

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Marshall Cavendish
Corporation

Mark: WE CAN READ ABOUT NATURE!

Serial No: 76/090,373

Filed: July 17, 2000

Law Office: 110

Examining Trademark

Attorney: William P. Jacobi

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ON APPEAL

06-14-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

TO: Trademark Trial and Appeal Board
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S BRIEF ON APPEAL UNDER
37 C.F.R. § 2.142(b) WITH EXHIBITS**

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June 15, 2002

TRADEMARK TRIAL AND
APPEAL BOARD
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INTRODUCTION

Applicant Marshall Cavendish Corporation appeals from a final refusal by the Examining Trademark Attorney to register applicant's mark WE CAN READ ABOUT NATURE!, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of U.S. Registration 2,293,847 (the '847 registration) for the mark "I CAN READ ABOUT" for a series of children's books. The present application was filed on July 17, 2000, on an intent-to-use basis under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The goods are identified as a "non-fictional nature book series for young readers featuring topics on camouflage, habitat, identification of species, and life cycles, and for enabling the reader to build vocabulary and strengthen phonic skills", in International Class 16.

RELATED APPLICATION

Applicant also owns pending Application Serial Number 76/090,722 (the '722 application) for the trademark WE CAN READ!. The '722 application was filed also on July 17, 2000, based on use in commerce under Section 1(a) of the Act. Certain evidence concerning the '722 application has been made of record in the file of the present application and is discussed below. The opposition period for the '722 application has passed and registration of applicant's WE CAN READ! mark is expected in due course.

PROSECUTION HISTORY

In a first Office action mailed January 12, 2001 (Action No. 01), registration of the present mark - WE CAN READ ABOUT NATURE! - was refused under Section 2(d) of the Trademark Act on grounds that applicant's mark, when used in connection with the identified goods, so resembles the mark of the '847 registration (I CAN READ ABOUT) as to be likely to cause confusion, to cause mistake, or to deceive. The action stated, at the middle of page 2, that "the marks create a similar commercial impression because they both contain the common wording "CAN READ ABOUT". It was also alleged that "[t]he average purchaser, who retains a general impression of marks, is *not* likely to distinguish between the pronouns 'I' and 'WE,' since this is not the dominant wording in the marks" (emphasis added). Although applicant's mark contains the term NATURE, such was held not to distinguish the mark from that of the '847 registration, and, "[g]iven the phraseology of the registrant's mark, consumers are likely to believe that the applicant's mark is for another book in the series published by the registrant." Action No. 01, page 2.

Applicant filed a response to the first Office action on June 11, 2001. At page 3 of the response, applicant noted that purchasers of applicant's and registrant's book series are individuals who work in the academic field and are likely to discriminate among books they purchase not only by way of the book series names, but by way of the publisher's names as well. Applicant also argued that when compared in their entirety the marks at issue do not convey a confusingly similar impression, noting that

applicant's mark is prefaced with the pronoun "WE" while that of the '847 registration begins with "I", and that the registered mark is open-ended without evidence that the registrant ever joined the word "NATURE" to "I CAN READ ABOUT" on its book series.

A final refusal to register the present mark under Section 2(d) was mailed from the Office on August 29, 2001 (Action No. 02). The Trademark Attorney maintained that the marks at issue are "highly" similar in sound and appearance, and stated at the top of page 2 of the final refusal that "[t]he applicant has *merely* changed the indistinguishing pronoun at the beginning of the [registrant's] mark and has *merely* added the term 'NATURE' to the end of the mark" (emphasis added). Cases were cited for the proposition that "the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d)", and the Trademark Attorney repeated his contention that "given the phraseology of the registrant's mark, consumers are likely to believe that the applicant's mark is for another book in the series published by the registrant."

Applicant filed a response to the final Office action on February 27, 2002. Included with the response was an Amendment to Allege Use (AAU) with specimens showing the present mark as used in commerce on applicant's book series. Copies of the specimens that were annexed to the AAU are attached to this brief for the convenience of the Board as Exhibits A and B. A Notice of Acceptance of applicant's AAU was mailed from the Office on April 2, 2002.

Included with applicant's response to the final action was a Declaration under 37 C.F.R. § 2.20 of applicant's vice president of marketing and operations, Richard Farley, with exhibits. Mr. Farley's declaration pointed out that since September 1999, applicant has published and sold a companion book series under the mark WE CAN READ!. Applicant's WE CAN READ! mark is the subject of the mentioned '722 application wherein applicant's goods are identified as a "book series for young readers featuring fictional stories and illustrations of animal characters, for enabling the reader to build vocabulary, strengthen phonic skills, and explore relationships with others".

An exhibit comprising the cover and pages 10 and 11 of applicant's Benchmark Books 2001-2002 catalog was also included with Mr. Farley's Declaration, and the same exhibit is annexed to this brief for the convenience of the Board as Exhibit C. The present mark - WE CAN READ ABOUT NATURE! - is shown on applicant's books at page 10 of Exhibit C, and applicant's companion WE CAN READ! series is shown on oppositely facing catalog page 11. Referring to Exhibit C, Mr. Farley pointed out that both of the WE CAN READ! and the WE CAN READ ABOUT NATURE! series have a library binding, contain 32 pages, measure 6-1/4 by 8-7/8 inches, have an interest level of grades 1-2, and feature color images of real animals. Further, the cover designs and type styles used for the books of each series resemble one another in appearance. Farley Declaration, par. 6. Moreover, both book series are advertised together in "School Library Journal" having a circulation of about 39,000 in the United States, and in "Booklist" with a circulation of about 29,000. Farley Declaration, par. 8. In view of the common physical and marketing attributes of the two

series, Mr. Farley submitted that persons already familiar with applicant's WE CAN READ! series will be more likely to identify the WE CAN READ ABOUT NATURE! series with the applicant, rather than with the owner of the '847 registration. Farley Declaration, par. 10. Pages 10 and 11 of Exhibit C also show that each book of either series has a list price of \$14.95.

In its response to the final action, applicant also maintained its belief that the marks at issue are not confusingly similar to one another when compared in their entireties, noting that the present mark begins with "WE" and ends with "NATURE", while the registered mark begins with "I" and ends with "ABOUT". See Response to Final Office Action, pages 3 and 4. Applicant also noted there was no evidence of record that purchasers would expect the registrant to use the word "NATURE" after "I CAN READ ABOUT", even if registrant published a book series relating to nature topics as suggested at the middle of page 2 of the final Office action. Applicant argued that words other than those which form the '847 registration should not be "added" to the registered mark when considering likelihood of confusion with applicant's mark. See final response, at page 4. A Notice of Appeal was filed concurrently with the response on February 27, 2002.

A further Office action was mailed April 2, 2002 (Action No. 03), in which the Trademark Attorney maintained the final refusal under Section 2(d). In addition, "Internet" evidence was offered to show a number of "I CAN READ ABOUT" publications of the registrant, including "I CAN READ ABOUT REPTILES"; "I CAN READ

ABOUT EARTHQUAKES AND VOLCANOS”; and “I CAN READ ABOUT WEATHER”.

No publication of registrant entitled “I CAN READ ABOUT NATURE” was identified, however.

To assist the Board in comparing applicant’s book series with that of the registrant, pages taken from the Internet evidence are attached hereto as Exhibits D, E, F and G. As seen, for example, on Exhibit E, the registrant’s mark I CAN READ ABOUT is highlighted and centered at the top edge of the book cover, and a specific book title, e.g., “Earthquakes and Volcanoes”, is centered below the mark. Both Exhibits D and E show that registrant’s books are softbound, proportioned physically wider than high, and have a list price of \$4.95 each. By contrast, Exhibit C shows that applicant’s books are library bound, physically higher than wide, and have a list price of \$14.95 each.

ARGUMENT

I. There Is No Likelihood of Confusion under Section 2(d)

Resolving the issue of likelihood of confusion requires the marks at issue to be compared in their entireties with one another, and considered in connection with the particular goods on which they are used. T.M.E.P. § 1207.01 (Jan. 2002). When, as in the present case, the marks under consideration form parts of literary titles,

“courts often take into consideration the total visual impression of the whole item reaching consumers. Such factors as book or magazine *size, format and distinguishing words and designs* are relevant.” McCarthy on Trademarks and Unfair Competition, § 10:15, at pages 10-32 to 10-33 (03/2002) (emphasis added).

And, with respect to book titles, “there is a reluctance to find unfair competition because book buyers generally place more importance upon the author than on the title of the book.” *Id.*, at page 10-34.

The applicant's and the registrant's book series do differ significantly from one another in appearance, quality and cost. For example, applicant's book covers, shown on the first pages of Exhibits A and B, display the present mark using the following letter case and boldface type: WE CAN READ about **NATURE!**. The mark is framed above and below by two horizontal lines, and a wildlife design is placed prominently between the top of the framed mark and the top edge of applicant's books. The registrant displays its mark as “I Can Read About”, and contains it within a

highlighted band along the top edge of its books as seen in Exhibits E, F and G.

Applicant's books are dimensioned higher than they are wide, while registrant's books measure wider than they are high. Applicant's books are hardbound and are priced at \$14.95 each. The registrant's books are softbound and are priced at \$4.95 each.

Accordingly, the differences in format, identifying symbols, cost and other characteristics of applicant's and registrant's book series, as well as the dissimilar word marks used on the respective goods, all tend to negate any reasonable likelihood of confusion in the marketplace. See *Palmer v. Gulf Publishing Co.*, 79 F. Supp. 731, 739, 78 U.S.P.Q. 349 (S.D. Cal. 1948).

While applicant's and registrant's marks do share the common words CAN READ ABOUT, such words are not particularly distinctive in relation to the subject goods, namely, a series of children's books. Because of this, purchasers will likely place more emphasis on the first words of the marks to distinguish them from one another. That is, because the common element of the marks is suggestive of the goods, consumers will tend to look to other, non-descriptive portions of the marks to avoid confusion. The use of distinctly different pronouns as first terms in the marks at issue allows consumers a means to distinguish the two marks from one another. *Miss World (UK) Limited V. Mrs. America Pageants*, 856 F.2d 1445 (9th Cir. 1988) ("Miss World" held not confusingly similar to "Mrs. of the World", both for beauty pageants). See also, *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir 1986); and T.M.E.P. § 1207.01(b)(viii)(Jan. 2002).

Applicant also submits that it is improper to assume that consumers familiar with registrant's mark will tend to believe that applicant's books are another in the series of "I Can Read About" books from registrant. As used on its books, applicant's mark is framed and stands alone as a series mark toward the top of the book covers. A specific book title, e.g., "ANIMAL TALK" or "BUSY BUILDERS" (see Exhibits A and B) follows below the mark. By contrast, registrant's mark is printed and used in such a manner as to form an overall title such as "I Can Read About Reptiles" or "I Can Read About Weather" (see Exhibits D and G). Accordingly, a fairer test of likelihood of confusion than that applied in the Office actions would be to compare one of registrant's overall titles, for example, "I Can Read About Reptiles", with applicant's mark as combined with one of applicant's titles, e.g., "WE CAN READ ABOUT NATURE! ANIMAL TALK". Such a comparison would leave no doubt that the § 2(d) issue should be resolved in favor of applicant.

II. Applicant's Companion WE CAN READ! Series and '722 Application Further Diminish any Likelihood of Confusion

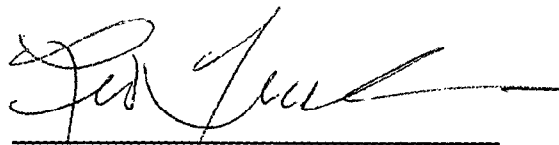
Since September 1999, applicant has advertised and sold its WE CAN READ! series in the same market to which the present WE CAN READ ABOUT NATURE! series is advertised and sold. As seen in Exhibit C, the books of the two series are identical to one another in physical dimensions and bindings, use cover designs and type styles that resemble one another in appearance, and both include color images of real animals. Since applicant's earlier published series also uses the

pronoun "WE" followed by "CAN READ" as a series mark, persons familiar with applicant's WE CAN READ! series and registrant's I CAN READ ABOUT series are not likely to assume applicant's newer WE CAN READ ABOUT NATURE! books are simply new additions to registrant's series.

CONCLUSION

In view of all the foregoing, the refusal of the Examining Trademark Attorney to register WE CAN READ ABOUT NATURE! under Section 2(d) of the Trademark Act should be reversed, and the application allowed to pass to publication.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Leo Zucker", with a long horizontal flourish extending to the right.

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June 15, 2002